

obviousness of the new claims 14 to 26.

The reasons for the rejection in the Office Action on page 4 state that it would have been obvious for one of ordinary skill in the art to optimize the amounts of the ingredients and would expect the optimized composition to have “similar” properties.

However none of the prior art references disclose or suggest that combination of four critical ingredients or that the amounts of the four critical ingredients are **result-effective variables** for obtaining the desired property, namely a nacreous luster. Although dye compositions of known ingredients disclosed in the prior art that can be optimized by routine experimentation are considered obvious according to M.P.E.P. 2144.05, the parameters that are optimized must first be recognized in the art as “result-effective” parameters, i.e. parameters whose variation will achieve a recognized result or improvement in the composition.

There is simply no suggestion in any of the three cited references, Pratt, et al; Allwohn, et al; or Cannell, et al, that the variation of the respective amounts of fatty alcohol, alkanolamide, alkoxyate, and anionic surfactant will optimize the properties of e.g. the dye compositions of Pratt, et al, and especially there is no suggestion or disclosure that a nacreous luster may be obtained by adjustment of these four variables. This goes way beyond “routine experimentation” or routine manipulation of parameters recognized as important in these references.

The reasonable expectation of success that is the basis for a case of prima facie obviousness is lacking here. The disclosures in the three prior art

references provide no basis for expecting a nacreous luster effect will occur after a reasonable amount of "routine experimentation". Besides the four classes of ingredients in the required combination, i.e. the fatty alcohol, alkanolamide, alkoxylate, and anionic surfactant, at least 50 different other classes of ingredients are mentioned in e.g. Pratt, et al.

The amount of experimentation required to find that the concentrations of the four types of ingredients must lie within the claimed concentration ranges clearly would greatly exceed the amount of experimentation that would be considered "routine experimentation".

It is well to remember that the applicants' disclosure in the applicants' specification cannot be employed as a guide to pick and choose ingredients from the prior art without some suggestion in the prior art that the ingredients should be combined. For example, the Federal Circuit Court of Appeals has said:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification....Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 U.S.P.Q. 2nd 1780, 1783-84 (Fed. Cir. 1992).

In the present case it is respectfully submitted that one skilled in the art would not arrive at the combination of the four ingredients in the claimed amount

ranges according claims 14 and 26 from the disclosures of Pratt, et al, and the secondary references unless he employed the disclosure in the applicants' specification as a guide to pick and chose ingredients and amounts. One skilled in the art would probably not even consult these prior art references when trying to provide dye compositions with a nacreous luster.

Furthermore with respect to new dependent claim 22 Pratt, et al, do **not** disclose or suggest that their dye compositions do **not** contain any monomeric quaternary ammonium compounds or do **not** contain cationic emulsifiers or surfactants as stated on page 3, first paragraph, of the Office Action. Pratt, et al, **teach the opposite** from the embodiments claimed in new dependent claim 22. According to paragraph [0114] cationic surfactants are acceptable ingredients in their compositions and according to paragraph [0127] many monomeric quaternary ammonium compounds may be included in their compositions.

Teaching in a prior art reference of doing the opposite from the claimed invention must be fairly considered according to the Federal Circuit Court of Appeals, who have said:

"In determining whether such a suggestion [of obviousness] can fairly be gleaned from the prior art...It is indeed pertinent that these references teach against the present invention. Evidence that supports, rather than negates, patentability must be fairly considered." ***In re Dow Chemical Co.***, 837 F.2d 469,473, 5 U.S.P.Q.2d 1529, 1532 (Fed.Cir. 1988)

The generic teaching in the reference regarding cationic surfactants is clearly the opposite from the embodiments claimed in claim 22.

The paragraphs [0147] to [0150] cited in regard to the absence of cationic

surfactants and monomeric ammonium compounds in Pratt, et al, only disclose test compositions and comparative compositions that are formulated very simply in order to determine the resulting colors of hair dyed with the different azo dye compounds proposed by Pratt, et al and with comparative compounds (anionic dyes). These test compositions have a pH of 10 and contain sodium lauryl sulfate, benzyl alcohol, ammonium hydroxide, hydrogen peroxide and water.

It is true that these test compositions of Pratt, et al, do not include cationic surfactants or monomeric ammonium compounds. However their absence is merely accidental. It is due to the fact that the test compositions are not intended to be marketed cosmetic compositions with other additives, such as perfume oil and the like. Any of a vast number of compositions in the art that do not contain cationic surfactants could have been cited.

That claim 22 depends on claim 14 and effectively includes its subject matter should not be ignored. It is respectfully submitted that the examples in paragraphs [0147] to [0150] of Pratt, et al, would not lead one skilled in the cosmetic arts to exclude cationic surfactants and monomeric ammonium compounds from dye compositions that include the four required ingredients, namely fatty alcohol, alkanolamide, alkoxylate, and anionic surfactant, especially in order to obtain a stable nacreous effect.

It is respectfully submitted that Pratt, et al; Allwohn, et al; and Cannell, et al, do not establish a case of *prima facie* obviousness of the combined subject matter of claims 22 and 14. The teaching of the acceptability of cationic surfactants in paragraph [0114] of Pratt, et al, should not be ignored.

Page 4 of the Office Action in the last paragraph states that there is no evidence on the record that the amount ranges and claimed ratios of the four ingredients are critical.

A Declaration accompanies this amendment that includes a report of experimental results showing that it is critical that the respective amounts of the four ingredients are within corresponding amount ranges according to claims 14 and 26. Samples of three different dye carrier compositions 1, 1A, and 1B were tested to determine whether or not they exhibited a nacreous luster. Two of the dye carrier compositions (1 and 1A) were compositions of the invention as claimed in claims 14 and 26. One of the test compositions (1B) was a comparative composition that contained the same four ingredients as the other compositions (1 and 1A), except that the amount of the alkanolamide was outside and below the claimed amount range of claims 14 and 26.

The results in the Declaration, which were obtained by visual observations of a panel of experts, by observing photographs of samples of the three compositions 1, 1A and 1B placed between glass panes, and by observation of photomicrographs of the compositions, showed that the comparative composition 1B that was not of the invention did not have a nacreous luster but the two compositions according to the invention did have a stable nacreous luster.

Thus the results in the Declaration clearly show that it is critical to keep the amount of the alkanolamide within the claimed concentration range in order to obtain the nacreous luster effect. The results clearly show the criticality of this

parameter recited in claims 14 and 26.

For the foregoing reasons it is respectfully submitted that new claims 14 to 26 should **not** be rejected as obvious under 35 U.S.C. 103 (a) over Pratt, et al (US 2004/019982 A1), in view of Allwohn, et al (US 6,372,203).

For the foregoing reasons it is respectfully submitted that new claims 14 to 26 should **not** be rejected as obvious under 35 U.S.C. 103 (a) over Pratt, et al (US 2004/019982 A1), in view of Allwohn, et al (US 6,372,203), and further in view of Cannell, et al (US 6,015,574).

## **2. W. ABELS, et al**

Claims 1 to 13 were rejected as obvious under 35 U.S.C. 103 (a) over W. ABELS, et al (DE 3834142).

New claims 14 to 26 replace canceled claims 1 to 13.

W. Abels, et al, disclose a storage stable oxidation hair dye composition that is in the form of a cream with a dye compound content. See the fourth and fifth paragraph of the specification of Abels, et al (English translation is available from the EU website). The same composition is disclosed in the English abstract of Abels, et al. This composition contains 29.0 – 86.2 wt. % water, some minor additive ingredients including perfume oil, 0.1 to 20.0 wt. % of oxidation dye compounds, and 13.6 to 41.0 wt. % of a mixture of the following composition:

2.0 to 6.0 wt. % C<sub>14</sub>- C<sub>20</sub>-fatty alcohol,  
4.0 – 10.0 wt. % glyceryl monodistearate,  
2.0 – 6.0 wt. % cocosfatty acid monoethanolamide

0.5 – 4.0 wt. % glycol distearate,  
4.0 – 7.0 wt. % lauryl alcohol, ethoxylated with 2 mole EO,  
0.01 – 1.0 wt. % cocosfattyacid-2-sulfoethyl ester, sodium salt,  
1.0 – 5.0 wt. % sodium lauryl alcohol diglycol ether sulfate,  
0.0 – 2.0 wt % quaternized homopolymerizate  
of dimethylaminoethyl metacrylate.

W. Abels, et al, does not teach or suggest that this composition has a luster or a nacreous luster. The purpose of W. Abels, et al, is to provide a stable hair dye containing composition in the form of a cream that has from 0.1 to 20.0 wt. % of the dye mixture, preferably a large amount of dye compounds (title of Abels, et al). This purpose is not directly related to obtain a dye composition with a nacreous luster.

As noted in the first paragraph on page 6 of the Office Action, the above-described compositions of W. Abels, et al, do include the four types of ingredients of the dye compositions according to claims 14 and 26, namely a fatty alcohol, an alkanolamide (cocosfattyacidmonoethanolamide), a fatty alcohol ethoxylate (lauryl alcohol ethoxylated with 2 mole EO), and an anionic surfactant (sodium lauryl alcohol diglycolsulfate).

The dye carrier compositions of W. Abels, et al, only include from 2.0 to 6.0 wt. % of the alkanolamide. In contrast applicants require from 6.1 to 20 wt. % of the alkanolamide, according to claims 14 and 26, which always means that a larger amount of alkanolamide is included in their compositions. Furthermore a case of prima facie obviousness should not be based on W. Abels, et al, because

the large amount range of claims 14 and 26 does not overlap the amount range of W. Abels, et al.

The comparative evidence in the accompanying Declaration compares the compositions 1 and 1A of the invention with amounts of the alkanolamide within the required amount range to a composition 1B with an amount range for the alkanolamide that is similar to that of the compositions of W. Abels, et al. Both the composition of W. Abels, et al, and comparative composition 1B as well as compositions 1 and 1A of the invention contain cocamide MWEA as the alkanolamide. The other three ingredients of the compositions are similar to each other. The results reported in the Declaration shows that the comparative composition 1B with 5.0 wt. % of the alkanolamide does not exhibit a nacreous luster effect.

Thus any case of prima facie obviousness based on W. Abels, et al, should be withdrawn due to the comparative evidence showing the criticality of the amount ranges for the alkanolamide in the accompanying Declaration.

For the foregoing reasons it is respectfully submitted that new claims 14 to 26 should **not** be rejected as obvious under 35 U.S.C. 103 (a) over W. ABELS, et al (DE 3834142).

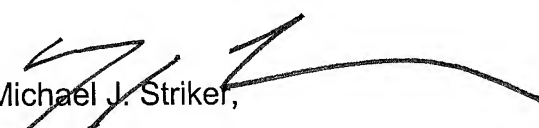
Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such



amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



Michael J. Striker,  
Attorney for the Applicants  
Reg. No. 27,233